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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/898,357	07/03/2001	Dennis P. Joyce	7000-075	1061
27820	7590	11/04/2004	EXAMINER	
WITHROW & TERRANOVA, P.L.L.C.			LY, NGHI H	
P.O. BOX 1287			ART UNIT	
CARY, NC 27512			PAPER NUMBER	
			2686	

DATE MAILED: 11/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/898,357

**Applicant(s)**

JOYCE ET AL.

**Examiner**

Nghi H. Ly

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Snyder et al (US 5,649,300) in view of Chern et al (US 6,381,465).

Regarding claims 1, 3, 12, 14 and 23, Snyder teaches a method for delivering content (see abstract) to a mobile terminal comprising: determining a location of the mobile terminal (see column 3 lines 26-40), defining a locality whose boundaries are determined without reference to a geographical location of control station and without reference to a

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communication range associated with the control station (see column 3, lines 50-62 and fig.1, the mobile units 20 can move freely inside predetermined area 10 and when the mobile units 20 are near any points of interest 16, they receive business advertisements from any points of interest 16, in Snyder, the term "near" means the area around the point of interest 16 and it reads on Applicant's "locality". In addition, the "points of interest 16" can be located anywhere inside predetermined area 10 and it reads on applicant's "boundaries are determined without reference to a geographical location of control station and without reference to a communication range associated with the control station"), associating content providers with the locality (see column 3, lines 50-62), determining if the locality encompasses the location of the mobile terminal (see abstract or see column 3, lines 50-62, "when the mobile unit 20 is near a point of interest 16"), accessing content from the content provider based on the locality and delivering the content to the mobile terminal (also see abstract or see column 3, lines 50-62, "the messages that system 12 delivers may be business advertisements that are presented when mobile units 20 are near the business").

Snyder does not specifically disclose a servicing base station and accessing content from the content provider based on the locality by sending a request to a content provider within the locality.

Chern teaches a servicing base station (see fig.1, base station 112) and accessing content from the content provider based on the locality by sending a request to a content provider within the locality (see column 6, lines 13-23, column 7, lines 50-65, and column 13, lines 50-64).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the above teaching of Chern into the system of Snyder so that services can be provided to the user based on what he/she needs.

Regarding claims 2 and 13, the combination of Snyder and Snyder further teaches the locality encompassing the mobile terminal is determined by: sending a request to a locality service to associate the location of the mobile terminal with a locality encompassing the location of the mobile terminal (see Chern, column 6, lines 13-23, column 7, lines 50-65, and column 13, lines 50-64), receiving a response from the locality service identifying the locality encompassing the location of the mobile terminal (see Snyder, abstract), and the locality service includes a plurality of locations defining geographic areas (also see Snyder, abstract or see column 3 lines 50-62).

Regarding claims 4 and 15, the combination of Snyder and Chern further teaches the step of accessing content is further based on a type of content desired by a user of the mobile terminal (see Chern, column 6, lines 13-23, column 7, lines 50-65, and column 13, lines 50-64).

Regarding claims 5 and 16, the combination of Snyder and Chern further teaches the step of accessing content is further based on characteristics of a user of the mobile terminal (also see Chern, column 6, lines 13-23, column 7, lines 50-65, and column 13, lines 50-64).

Regarding claims 6 and 17, Snyder further teaches the locality defines a recognized geographic area (see abstract or see column 3, lines 50-62, "when the mobile unit 20 is near a point of interest 16").

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Regarding claims 7 and 18, Snyder further teaches the locality defines a geographic area about a point of presence for a content provider (also see abstract or see column 3, lines 50-62, "when the mobile unit 20 is near a point of interest 16").

Regarding claims 8 and 19, Snyder further teaches the content accessed based on locality relates to a point of presence within the locality (also see abstract or see column 3 lines 50-62, "when the mobile unit 20 is near a point of interest 16").

Regarding claims 9, 11, 20 and 22, Snyder teaches a method for delivering content to a mobile terminal (see abstract) comprising: determining a location of the mobile station (see column 3, lines 26-40), defining a locality whose boundaries are determined without reference to a geographical location of a serving base station and without reference to a communication range associated with the servicing base station (see column 3, lines 50-62 and fig.1, the "points of interest 16" can be located anywhere inside predetermined area 10 or whose boundaries are determined without reference to a geographical location of control station 18 and without reference to a communication range associated with the control station 18), associating content providers with the locality (see column 3, lines 50-62), determining if the locality encompasses the location of the mobile terminal (see abstract or see column 3, lines 50-62, "when the mobile unit 20 is near a point of interest 16") and delivering the content to the mobile terminal (see column 3, lines 26-40), and defining a zone of acceptance around the mobile terminal (Snyder teaches determining the position of the mobile terminal is based on GPS, see column 7, lines 1-15, the teaching of Snyder inherently teaches applicant's "defining a zone of acceptance around the mobile terminal" (since mobile terminal's GPS position is

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centered on the current position of the mobile terminal) and wherever the mobile terminal goes, the zone around the mobile terminal will follow. In addition, applicant's specification (page 9, lines 21-23) discloses "*the circle about (not around as claimed) the mobile terminal 16 represents a zone of acceptance defined by the mobile terminal 16 user in a user profile. The zone of acceptance is centered on the current position of the mobile terminal and includes an advertiser point of presence A3*") and determining if the zone of acceptance overlaps any position of the locality (see column 3, lines 50-62 and fig.1, the mobile units 20 can move freely inside predetermined area 10 and when the mobile units 20 are near any points of interest 16, they receive business advertisements from any points of interest 16, in Snyder, the term "near" means the area around the point of interest 16 and it reads on Applicant's "locality" and the zone around the mobile terminals will follow and overlap the area around the points of interest 16 when mobile terminals are near any points of interest 16).

Snyder does not specifically disclose associating content providers encompasses the location of the mobile terminal, accessing a profile associated with the user of the mobile terminal, accessing the content from the content provider based on the locality wherein is based on criteria within the profile such that the criteria further identified a type of content to access.

Chern teaches associating content providers encompasses the location of the mobile terminal (see column 6, lines 13-23), accessing a profile associated with the user of the mobile terminal (see column 7, lines 50-65), accessing the content from the content provider based on the locality wherein is based on criteria within the profile such



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that the criteria further identified a type of content to access (see column 6, lines 13-23 and column 13, lines 50-64, in addition, applicant's specification page 3, lines 6-8 and page 5, lines 19-20 disclose a profile is created by the user to identify the content or type of content to receive).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the above teaching of Chern into the system of Snyder so that services can be provided to the user based on what he/she needs.

Regarding claims 10 and 21, Snyder further teaches accessing a profile associated with a point of presence with the locality (also see abstract or see column 3 lines 50-62, "when the mobile unit 20 is near a point of interest 16") and the step of accessing the content is further based on criteria within the profile such that the criteria further identifies the type of content to access (see column 5, lines 16-19).

### ***Response to Arguments***

4. Applicant's arguments filed 07/14/2004 have been fully considered but they are not persuasive.

On pages 7 and 8 of applicant's remarks, applicant argues that there is no motivation to combine the references.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the

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references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to do so found in the knowledge generally available to one of ordinary skill in the art so that services can be provided to the user based on what he/she needs.

On page 7 of applicant's remarks, applicant argues that Snyder does not teach or suggest "accessing content from the content provider based on the locality by sending a request to a content provider within the locality".

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, Chern teaches accessing content from the content provider based on the locality by sending a request to a content provider within the locality (see column 6, lines 13-23, column 7, lines 50-65, and column 13, lines 50-64), and the combination of Snyder and Chern indeed teaches applicant's claimed invention. In addition, applicant's attention is directed to the rejection of claim 1 above.

On page 8 of applicant's remarks, applicant argues that "Such hindsight reconstruction is impermissible, and this impermissible reconstruction makes the combination improper".

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that

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any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

### **Conclusion**

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nghi H. Ly whose telephone number is (703) 605-5164. The examiner can normally be reached on 8:30 am-5:30 pm Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on (703) 305-4379. The fax phone

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number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nghi H. Ly

*10/19/04*

*Marsha D. Banks-Harold*

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